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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re the Application of

Yoshifumi IIDA et al.

Group Art Unit: 1756

Application No.: 09/987,413

Examiner: C. Rodee

Filed: November 14, 2001

Docket No.: 111115

For: TONER FOR DEVELOPING AN ELECTROSTATIC LATENT IMAGE,  
DEVELOPER, DEVELOPER UNIT, AND METHOD FOR FORMING AN IMAGE

REQUEST FOR RECONSIDERATION

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

In reply to the March 25, 2003 Office Action and in view of the following remarks, reconsideration of this application is respectfully requested. Claims 1-7, 9-15, 18 and 19 are pending in the application.

**I. Rejections Under 35 U.S.C. §103(a)**

Claims 1, 2, 5-7, 9-11 and 13-15 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication No. 2002/0022190 A1 (Iizuka) in view of U.S. Patent No. 4,855,204 (Fujii).

Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Iizuka in view of Fujii as applied to claims 1, 2, 5-7, 9-11 and 13-15 above, and further in view of U.S. Patent No. 5,922,500 (Iida).

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iizuka in view of Fujii as applied to claims 1, 2, 5-7, 9-11 and 13-15 above, and further in view of *Handbook of Imaging Materials* to Diamond, pgs. 222-224.

Each of the foregoing rejections is respectfully traversed. Specifically, Applicants submit that the teachings of Iizuka cannot be relied upon under 35 U.S.C. §103(a), and thus that each of the foregoing rejections must be withdrawn.

According to 35 U.S.C. §103(c), subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of §102, shall not preclude patentability under §103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Applicants submit that Iizuka qualifies as prior art against the present claims, if at all, at best only under 35 U.S.C. §102(e). Iizuka was published February 21, 2002 (after the November 14, 2001 filing date of the present application), but was filed in the United States on May 18, 2001.

Iizuka is assigned to Fuji Xerox Co., Ltd., as noted on the cover of Iizuka. The present application is also assigned to Fuji Xerox Co., Ltd. as confirmed by the Assignment recorded at Reel 012307, Frame 0358 of the Patent Office's microfilm records. Applicants confirm that Iizuka and the present invention were, at the time the invention was made, commonly owned by Fuji Xerox Co., Ltd. or subject to an obligation of assignment to Fuji Xerox Co., Ltd. Accordingly, in view of 35 U.S.C. §103(c), the subject matter of Iizuka cannot preclude patentability of the present invention under 35 U.S.C. §103(a).

For at least the foregoing reasons, Applicants submit that all of the foregoing rejections of the claims under 35 U.S.C. §103(a) relying upon Iizuka are improper.

Still further, Applicants submit that Iizuka would not have led one to the present invention. Iizuka merely discloses a developer used for a trickle developing method. Nowhere does Iizuka teach or suggest a toner for developing an electrostatic latent image comprising a white color toner particle, as recited in claims 1 and 11 of the present invention.

Accordingly, Applicants respectfully submit that the teachings of Iizuka cannot be relied upon under 35 U.S.C. §103(a), but even if they are relied upon, Iizuka would not have led one of ordinary skill in the art to the invention of claims 1 or 11, or any depending claims 2, 5-7, 9, 10 and 13-15. Reconsideration and withdrawal of these rejections are thus respectfully requested.

**II. Election/Restriction Requirement**

The method claims of Group II (claims 18 and 19) include the limitations of the product claims of Group I. Thus, Applicants respectfully request that upon allowance of the product claims, the method claims be rejoined with the application and similarly allowed.

**III. Conclusion**

In view of the foregoing remarks, Applicants submit that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-7, 9-15, 18 and 19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:LMS/rxg

Date: June 24, 2003

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